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**REMARKS**

Claims 1, 3-8, 10-16, and 18-23 are pending in the application.

It is noted that the claims amendments are made only for pointing out the claimed invention more particularly, and not for distinguishing the invention over the prior art, narrowing the claims, or for statutory requirements for patentability. Further Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 3-8, 10-16, and 18-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by SCHWARTZ (U.S. Patent Publication No. 2002/0091777).

Applicant respectfully traverses these rejections in the following discussion.

**I. THE CLAIMED INVENTION**

An exemplary aspect of the claimed invention, as recited in independent claim 1, is directed to a method of automatically replying to a received e-mail in a mobile terminal having a function of transmitting and receiving an e-mail, the method including determining whether to automatically reply to the received e-mail, determining whether the received e-mail originates from a known address, determining whether text data is associated with the known address, determining whether image data is associated with the known address, editing the image data in accordance with the known address, automatically transmitting the image data determined in accordance with the known address of the received e-mail to the address if the method determines to automatically reply to the received e-mail.

Another exemplary aspect of the claimed invention, as recited in independent claim 6, is directed to a method of automatically replying to a received e-mail in a mobile terminal

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having a function of transmitting and receiving an e-mail, including checking whether an address of a transmitter of a received e-mail is stored in a memory, checking whether image data associated with the address is stored in the memory, editing the image data in accordance with the address, and transmitting the image data to the address.

Another exemplary aspect of the claimed invention, as recited in independent claim 11, is directed to a mobile terminal having functions of transmitting and receiving an e-mail, and automatically replying to a received e-mail, comprising a controller for automatically transmitting image data determined in accordance with an address of a transmitter of the received e-mail.

Another exemplary aspect of the claimed invention, as recited in independent claim 19, is directed to a computer readable medium having a program for causing a computer to carry out a method of automatically replying to a received e-mail in a mobile terminal comprising a function of transmitting and receiving an e-mail, wherein steps executed by said computer in accordance with said program include and automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, to said address, from a terminal.

Another exemplary aspect of the claimed invention, as recited in independent claim 20, is directed to a computer readable medium comprising a program for causing a computer to carry out a method of automatically replying to a received e-mail in a mobile terminal comprising a function of transmitting and receiving an e-mail, wherein steps executed by the computer in accordance with the program include checking whether an address of a transmitter of a received e-mail is stored in a memory, checking whether image data associated with said address is stored in said memory, checking whether text data is

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associated with the known address, editing the image data in accordance with the known address, and transmitting said image data to said address.

Conventional automatic e-mail response devices require that the server perform the forwarding of e-mails. Further, conventional automatic e-mail response methods, however, only allow characters and letters for making a response. Thus, the conventional automatic e-mail response results in reduced visibility. In addition, these characters and letters are predetermined by the manufacturer and therefore cannot be edited or revised by the user.

The claimed invention, however, includes “editing said image data in accordance with said address,” as recited, for example, in independent claim 6. This is important for providing visibility to a user and to allow the user to edit a response e-mail (e.g., see Application at page 3, lines 25-29). Furthermore, the claimed invention also provides, “a controller for automatically transmitting image data determined in accordance with an address of a transmitter of the received e-mail,” as recited in independent claim 11. This feature is important for allowing the terminal itself to respond to and automatically forward e-mails (e.g., see Application at page 4, lines 1-14).

## II. THE ALLEGED PRIOR ART REFERENCES

### A. Independent Claims 1, 6, and 20

Independent claims 1, 6, and 20 recite, among other things, “editing the image data in accordance with the known address.”

On page 3 of the Office Action, the Examiner alleges that Schwartz discloses editing the image data in accordance with the address by alleging that Schwartz at paragraphs [0014 and 0015] “disclose Generating [sic] a reply file (i.e., editing image data) to be sent to a

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known sender (i.e., in accordance with the known address).);”

Contrary to the allegations of the Examiner, however, Schwartz does not disclose or suggest “editing said image data in accordance with said address,” as recited, for example, in independent claim 6, the “said address” being “an address of a transmitter of a received email.”

Instead, Schwartz discloses that the messages that are forwarded and selected “based on predetermined criteria.” See Schwartz, Paragraph 15. Further, this reply message is sent as stored. Furthermore, Schwartz then discloses that “the recipient may select from one or more standard messages and/or replay files or may generate sender-specific reply messages or files based on predetermined criteria.” (emphasis added) That is, these messages are pregenerated, and not edited.

Furthermore, Schwartz discloses that these messages are also stored at a “message server,” and not at mobile terminal, as recited, for example, in claim 6. Accordingly, the reply message does not undergo the “editing [of] said image data in accordance with said address,” as recited, for example, in independent claim 6.

Furthermore, while the Examiner, at page 13 of the Office Action, alleges that Schwartz discloses “editing the image data,” Schwartz does not disclose editing, but rather that a predetermined message is generated.

Therefore, Schwartz does not disclose or suggest that “editing said image data in accordance with said address,” as recited in independent claim 6, and similarly recited in independent claims 1 and 20. Accordingly, Applicant submits that independent claims 1, 6, and 20 are in condition for allowance.

With respect to claims 3-5, 7, 8, 10, and 21-23, which depend from independent

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claims 1, 6 and 20, respectively, each of these claims contain all the limitations contained within claims 1, 6 and 20 and therefore are also in condition for allowance.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

**A. Independent Claims 11 and 19**

On page 7 of the Office Action, the Examiner alleges that Schwartz discloses a controller for automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, as recited in independent claim 11 and on page 10 of the Office Action, the Examiner alleges that Schwartz also discloses the similarly recitation of independent claim 19, where data is transmitted "in accordance with an address of a transmitter of said received e-mail, to said address from a terminal."

Contrary to the allegations of the Examiner, however, Schwartz does not disclose or suggest a "mobile terminal having functions of transmitting and receiving an e-mail, and automatically replying to a received e-mail," as recited in independent claim 11 at paragraph [0001] of Schwartz. That is, the Examiner is relying on the statement that Schwartz acts automatically to disclose a portion of independent claim 11.

Instead of a controller that performs automatic transmission, Schwartz discloses that the messages that are forwarded and selected through the server and not at the terminal. See Schwartz, Paragraph 28 where

"on receipt of the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in particular, both the user's reply message profile and reply file profile, to determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be

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sent.” (*emphasis added*)

Therefore, Schwartz does not disclose or suggest “a controller for automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail,” as recited in independent claim 11 and as similarly recited in independent claim 19. Instead, the server performs the functions that the mobile terminal itself performs.

Furthermore, while the Examiner, at page 13 of the Office Action, alleges that Schwartz discloses “automatically transmitting image data,” Schwartz does not disclose a terminal that transmits, but rather that a server performs the transmission. Even at paragraph 14 of Schwartz, which was cited by the Examiner, Schwartz discloses that the reply messages and other files are stored at an associated message server, or database associated with that server, not at the terminal itself. Therefore, the terminal of Schwartz cannot act independently of the server. Accordingly, Schwartz does not disclose or suggest the controller recited in independent claims 11 and 19.

With respect to claims 12-16, and 18, which depend from independent claim 11, each of these claims contain all the limitations contained within claim 11 and are therefore also in condition for allowance.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

### III. FORMAL MATTERS AND CONCLUSION

On page 2 of the Office Action, the Examiner objects to claims 16, 20, and 21. Claim 16 has been amended to obviate the objection. With respect to claims 20 and 21, Applicant respectfully submits that these claims were amended in the Amendment filed May 2, 2008 to

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recite "the program comprising executable steps," (that is, the word "wherein" was deleted, rendering the phrase grammatically correct) and "computer readable medium of claim 20," respectively. Therefore, Applicant respectfully requests withdrawal of these objections.

In view of the foregoing, Applicant submits that claims 1, 3-8, 10-16, and 18-23, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

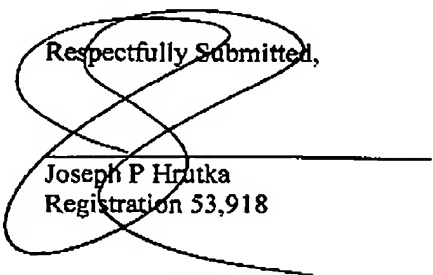
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Date:

9/29/08

Respectfully Submitted,

  
Joseph P Hrutka  
Registration 53,918Sean M. McGinn, Esq.  
Registration No. 34,386

**McGinn Intellectual Property Law Group, PLLC**  
8321 Old Courthouse Rd., Suite 200  
Vienna, Virginia 22182  
(703) 761-4100  
Customer No. 21254